

Casey J. Pelkey *et al.*
Application No. 09/724,908

Remarks

Reconsideration and allowance of the subject patent application are respectfully requested.

Applicants initially note that while claims 1-51¹ are identified as rejected, the office action provides no specific discussion with respect to the manner in which the proposed four-way combination of documents can be read onto claims 14, 15, 32, 33, 39 (independent), 40, 45, 48 (independent), 49 and 50. So that the record is clear, Applicants request that any further rejection of these claims provide a discussion explaining how the applied documents are allegedly combinable to provide the claimed subject matter.

Claims 1-51 were rejected under 35 U.S.C. Section 103(a) as allegedly being "obvious" over "First Internet Backgammon Server 1994 (FIBS)" in view of Instant Messaging Guide 1996 (IMG) in view of Tang *et al.* (U.S. Patent No. 5,960,173) and Darling (WO93/23125).

As described in the specification in connection with certain illustrative example embodiments, a video game program for a video game may be provided on a storage device (or medium) that is replaceably connectable to a video game system (or machine). The video game program includes program instructions both for the video game and for a messaging service client, whereby the messaging client is activated by connecting the storage device (or medium) to the video game system (or machine) and executing the video game program. *See, e.g.*, specification at, for example, page 20, lines 3 *et seq.* The activated messaging client establishes a connection between the video game system and a server. Among other things, because the video game program includes instructions both for a video game and for a messaging service client, access to a messaging service can be provided to video game players even if the video game system does not have a multi-tasking environment in which different applications can be active at the same time. Certain example embodiments also provide for a user of a video game system (or

¹ Claim 47 was previously canceled without prejudice or disclaimer and thus claims 1-46 and 48-51 are pending in this application.

Casey J. Pelkey *et al.*
Application No. 09/724,908

machine) to generate a "buddy list" that allows the user to determine activities in which his/her "buddies" on the list are engaged.

The documents applied in the office action against the claims do not render the subject matter of these claims obvious.

First, the FIBS document contains no disclosure of a video game program embodied on a storage device that is replaceably connectable to a video game machine that connects to a server over the Internet as variously described, for example, in independent claims 1, 10, 28, 29, 39 and 48. The FIBS document describes a backgammon game running on a FIBS server to which users connect, but there is no disclosure or suggestion of the program for this backgammon game being embodied on a storage device for a video game machine that connects to the FIBS server. That is, there is no disclosure or suggestion in the FIBS document of executing a video game program anywhere other than the server.

Second, there is no disclosure in the FIBS document that the program for the backgammon game itself include program instructions both for the game and for a messaging service client, whereby the messaging service client can be activated by connecting the storage device to the video game system and executing the video game program embodied thereon as further specified in independent claims 1, 10, 28, 29, 39 and 48. As discussed above, this feature enables a messaging service client to be provided for a video game system even in a non-multi-tasking environment. This is not a problem in the computer-based environment of the FIBS system and thus there is no disclosure or suggestion that the program for the backgammon game also include program code for a messaging service client.

Third, there is no disclosure in the FIBS document of executing a game program to activate a messaging service client, which then establishes a connection to a server as variously specified in claims 1, 10, 28, 29, 39 and 48. As noted above, in the FIBS document, the backgammon game is executed at the server and thus the activation of this game would not result in a connection to a server.

Fourth, the chat and player status features described in the FIBS document are limited to one game and thus there is no disclosure or suggestion in this document of players chatting with or seeing the status of players who are playing, for example, chess

Casey J. Pelkey *et al.*
Application No. 09/724,908

or an auto racing game. Thus, the FIBS document does not disclose or suggest providing information as to the games being played by one or more buddies on a buddy list as variously specified in claims 1, 39 and 48, for example.

The FIBS document describes a system that is fundamentally different than the subject matter of the pending claims. Applicants respectfully submit that, absent impermissible hindsight, it is quite difficult to envision how one of ordinary skill in the art starting with the FIBS backgammon game as proposed in the office action would (or could) have ever been led to modify this game so as to provide the subject matter described in the pending claims.

The IMG document does not remedy the deficiencies of the FIBS document. The IMG document describes instant messaging and various "popular" internet messaging clients. The instant messaging client described in the IMG document is a stand-alone client, and is not incorporated into a video game program or activated by executing a game program. There is also no disclosure of determining, for example, the gaming status of one of the buddies in a buddy list. Furthermore, the client is not described as being on a video game system or machine. Thus, even if the "buddy list" concept of the IMG document were somehow forcedly incorporated into the FIBS system, the claimed subject matter would not have resulted.

Tang *et al.* is applied as allegedly providing "further evidence that monitoring users on different computer (sic) using different applications was well known in conjunction with providing user communication." Tang *et al.* discloses user interfaces and methods for improving user collaboration based on "task proximity." Workers are task proximate when they are working on the same or related data, with the same or related applications, at about the same time.

First, Tang *et al.*, like the FIBS and IMG documents, fails to disclose or suggest, among other things, providing information about activities engaged in by video game system (or machine) users on a previously defined "buddy list." Instead, Tang *et al.* identifies "task proximate" workers and identifies these workers to the current worker:

The encounter window 20 provides a visual mechanism for informing the current worker which other workers are task proximate. The encounter mechanism further provides aural indication of task proximate workers. For those workers who are task proximate, the encounter mechanism

Casey J. Pelkey *et al.*
Application No. 09/724,908

provides a means for efficiently initiating an interaction with such workers.

...
The encounter window 20 is periodically updated as new workers become task proximate to the current worker, and other workers lose their task proximity. As either the current worker or other workers context switch between applications, the encounter window is updated to display the icons 22 of those workers who are then task proximate to the current worker. Tang *et al.*, col. 4, lines 31-59.

There is no provision in Tang *et al.* for the current worker to know the identity of a particular other worker unless that worker happens to be "task proximate." Instead, as described above, Tang *et al.* identifies "task-proximate" workers in order to facilitate communication regarding task-related issues. Thus, applying Tang's concept, a worker would only be identified if he/she is engaged in a task considered to be "proximate." This is quite different and not at all suggestive of determining the activities (*e.g.*, games) in which a previously defined list of "buddies" is engaged regardless of what those activities are. Here again, absent impermissible hindsight, Applicants respectfully submit that one of ordinary skill would have had little notion as to how Tang *et al.* is even relevant to the systems described in the FIBS and IMG documents, much less how to meaningfully incorporate features of Tang *et al.* into some combination of the systems described in these documents.

Second, Tang *et al.* contains no description of, among other things, a game program embodied on a replaceably connectable storage device that includes program instructions both for a video game and for a messaging service client, whereby the messaging service client is activated by connecting the storage device to the video game system and executing the video game program. As with the FIBS document and the IMG document, Tang *et al.* discloses a computer environment and thus there are no problems with different applications being active at the same time. Consequently, there is no disclosure or suggestion in Tang *et al.* that would have led one of ordinary skill in the art (absent the disclosure of the subject patent application) to incorporate program code for a messaging service client into a video game program. Thus, even were the teachings of Tang *et al.* somehow applied to the proposed FIBS-IMG combination, the claimed subject matter would not have resulted.

Casey J. Pelkey *et al.*
Application No. 09/724,908

Darling *et al.* is newly cited for its disclosure of communication between players. As described in Darling *et al.*, this communication takes place among players in a "game playing group":

It is also contemplated that at least some degree of direct communication may be provided between players within a game playing group. Depending on the input capabilities of the game machine, a message intended for another player may be selected from a menu of predefined messages or typing it on a keyboard. Also, a particular accomplishment of one player may result in a message being transmitted to all of the other game machines in the game playing group...Of course, such communications and messages would also form part of the information transmitted between the game machines in the game playing group. Darling *et al.*, page 9, lines 19-33.

Thus, Darling *et al.* describes communication among an already formed game playing group and contains a detailed description of how a new game machine can join a game. See, e.g., page 13, line 28 *et seq.*

Darling *et al.* simply describes forming a game playing group for playing a particular game and sending of messages among the players in this group. Darling provides no description, and is not suggestive of, providing information about activities engaged in by video game system (or machine) users on a previously defined "buddy list."

In addition, Darling *et al.* shows the communication program ROM 34 as being separate from the game program ROM 21. See, e.g., Darling *et al.*, Figure 1. Thus, Applicant respectfully submits that Darling *et al.* does not disclose or suggest the concept of incorporating program code for a messaging service client into a video game program. Applicants note Darling *et al.*'s suggestion on page 8 that the communication unit could be housed in the external game cartridge 20. However, this only suggests that the components of unit 30 may be housed in the game cartridge to allow upgrading of an existing game machine. This description does not suggest incorporating the messaging service client code into a video game program.

For at least these reasons, the addition of Darling *et al.* to the proposed combination of Tang *et al.* and the FIBS and IMG documents (even assuming proper

Casey J. Pelkey *et al.*
Application No. 09/724,908

motivation could be identified) would not have resulted in the subject matter of the pending claims.

New claim 53 has been added. The subject matter of this new claim is fully supported by the original disclosure and no new matter is added. Claim 53 depends from claim 48 and is believed to be allowable at least by virtue of this dependency.

The pending claims are believed to be allowable and favorable office action is respectfully requested.

Respectfully submitted,

NIXON & VANDERHYE P.C.



Michael J. Shea
Registration No. 34,725

1100 North Glebe Road, 8th Floor
Arlington, Virginia 22201
Telephone: (703) 816-4000
Facsimile: (703) 816-4100
MJS:mjs